

Atty. Dkt. No. 017309-0173-0125

REMARKS

Applicant is simultaneously filing a request for continued examination (RCE) under 37 C.F.R. § 1.114 and respectfully requests reconsideration of the present RCE application in view of the foregoing amendments and the following remarks. Claims 1-14 and new claims 36 and 37 are respectfully submitted for reconsideration. Support for new claim 36 can be found, for example, in original claim 1 and at page 7, lines 8-9 of the substitute specification, and support for new claim 37 can be found, for example, in original claim 13. These new claims should be examined along with elected claims 1-14.

I. Rejections Under 35 U.S.C. § 103(a)

Claims 1-2 and 8-9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tan et al. (USP 5,866,242). Claims 1-12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hou et al. (USP 4,288,462) in view of Tan et al. Claims 1-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hou (USP 4,488,969) in view of Tan et al. Applicant traverses these rejections of claims 1-14 for at least the following reasons.

Applicant submits that Tan et al. is not available as prior art against claims 1-14 because applicant reduced to practice the invention of claim 1 before the U.S. filing date of Tan et al. (i.e., before January 17, 1997). Applicant has attached declarations by Mr. Josef Otto Rettenmaier, the inventor of the subject application, and Dr. Peter Palgen, applicant's German patent attorney, evidencing that the invention of claim 1 was reduced to practice before January 17, 1997. Each declaration references Exhibits A-O (please note there is no Exhibit J). Applicant has provided English-language translations of the exhibits (except for exhibits I and K; translations of those exhibits can be provided if the examiner needs them).

The invention, as now claimed in claim 1, has been fully existent in the development department of applicant's company, J. Rettenmaier + Sohne GmbH & Co. KG, since at least the end of 1995. See Rettenmaier Declaration at paragraphs 2-3. On December 27, 1995, Mr. Rettenmaier sent Dr. Palgen a letter with two attachments. The attachments were two statements that describe Mr. Rettenmaier's

invention. In Germany, under certain circumstances, the government will partly finance research and development to support innovation. An applicant for such money has to file statements concerning his development work so that the governmental authority is able to judge whether the investments are sensible and justified. The first statement attached to the December 27, 1995 letter is a status report that reports the development results obtained up to November 30, 1995. The second statement attached to the December 27, 1995 letter reports the intended activities for the time after January 1, 1996 as a basis for an application for further support money. See Rettenmaier Declaration at paragraph 4 and Exhibit A (letter), Exhibit C (first statement), and Exhibit D (second statement); see Palgen Declaration at paragraph 3 and Exhibit A (letter), Exhibit C (first statement), and Exhibit D (second statement).

The two statements (Exhibits C and D) substantially disclose each feature of claim 1 of the present application. See Rettenmaier Declaration at paragraph 6; Palgen Declaration at paragraph 5. That is, the two statements (Exhibits C and D) disclose a filter aid which comprises finely divided wood particles. See Exhibit C page 1 under "1 Zusammenfassung der Ergebnisse" subtitle "Laugenbehandelter Holzfaserstoff", which means "wood fibre stock treated with alkali;" see also sections 2.1.5 and 2.3 of Exhibit C; see also paragraph 2 of section 3.2 of Exhibit D. Wood fibre stock is a kind of finely divided wood particles. The statements also disclose that the finely divided wood particles of the filter aid have been subjected to treatment with an alkali solution (laugenbehandelt = treated with alkali) at a temperature below 100°C and at atmospheric pressure. See Table in section 2.5 of Exhibit C, which discloses that the alkali treatment has taken place with a dilute alkali solution at a temperature below 100°C (0,1 - 0,4 %ige, heiße Natronlauge, Erhitzen der Natronlauge auf 90°C).

Although atmospheric pressure is not expressly mentioned in the statements, it is mentioned in an initial draft dated February 29, 1996 of the German patent application to which the present application claims priority. See claim 5 of Exhibit F of Rettenmaier Declaration; claim 5 of Exhibit F of Palgen Declaration.

According to the first statement (Exhibit C), the particles are subjected to the treatment to a degree sufficient to remove sensorially active substances from the wood particles and leave the wood particles as wood particles. See Exhibit C, page 1,

subtitle "Laugenbehandelter Holzfaserstoff", which reads "... ein chemischer Reaktionsschritt entwickelt, durch den sich der Anteil an extrahierbaren Bestandteilen in Holzfaserstoffen deutlich reduzieren lässt" (= developed a chemical reaction step, by which the part of extractable components in wood fibre stocks can be considerably reduced). The extractable components satisfy the "sensorially active substances" limitation in claim 1.

That the particles are left as wood particles (and do not become real cellulose) is not expressly mentioned in the two statements (Exhibits C and D), but it is clearly described in the initial draft of the German patent application (Exhibit F). See page 3, last paragraph, to page 4, paragraph 4, of Exhibit F.

The experiments described in the two statements (Exhibits C and D) were carried out with a product having the features of claim 1. Thus, as can be seen from the two statements (Exhibits C and D) and the initial draft of the German patent application (Exhibit F), applicants reduced the invention of claim 1 to practice long before January 1997. Accordingly, applicant submits that Tan et al. is not available as prior art against claim 1 of the present application, and applicant requests withdrawal of the section 103 rejections of claims 1-14 that rely on Tan et al.

II. Rejection Under 35 U.S.C. §102(b) and 35 U.S.C. §103(a)

Claim 1 is rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Thompson (USP 4,599,240). Applicant traverses these rejections of claim 1 for at least the following reasons.

Treatment of the wood particles in the invention of claim 1 is only carried out to a certain degree such that the wood character is maintained ("the particles are subjected to a treatment . . . to a degree sufficient to remove the sensorially active substances from the wood particles and leave the wood particles as wood particles"). This feature is not taught or suggested by Thompson.

Applicant has provided the declaration of Dr. Bernhard Gerdes, who has ten years of experience in filtration technologies. As recognized by Dr. Gerdes, Thompson teaches transforming a starting material to a purified fine fibered cellulose, instead of

maintaining wood particles as wood particles. Moreover, the starting material of Thompson is not wood. Column 3, lines 51-55, of Thompson read, "The raw materials to be employed in the process of the present invention for the production of purified cellulose may be any relatively non-ligneous, edible agricultural by-products having a significant alpha cellulose content present therein." Further, in column 4, lines 25-28, Thompson states that "The process of the present invention is not applicable on a practical basis to wood, stalk portions of plants, or even the husk portions of various cereal grains." From this and the remaining disclosure of Thompson, Dr. Gerdes concludes that a person of ordinary skill in the art would not be motivated by Thompson to take wood as a raw material and to treat it so that it remains wood and does not become something like purified cellulose. Leaving wood particles as wood particles, as required by claim 1, is contrary to the disclosure of Thompson. Besides, according to Dr. Gerdes, "one of ordinary skill in the art would not make conclusions as to filtration properties of a product according to Thompson, which teaches a purified and sterile cellulose powder suitable for use as an additive for products to be consumed by humans (see column 3, lines 8-10), where filtration properties are not relevant at all."

For at least these reasons, applicant traverses the rejection of claim 1 under 35 U.S.C. §102(b) and 35 U.S.C. §103(a).

III. New Claims 36 and 37

New claim 36 differs from claim 1 in that claim 36 additionally requires that the filter aid be "for use in forming prefloat filter layers for filtration of liquids." A person of ordinary skill in the art familiar with the first statement (Exhibit C) attached to Mr. Rettenmaier's December 27, 1995 letter would understand that filtrations of the kind discussed are usually effected by prefloat filter layers. The words "Anschwemmbarkeit" (= floatability) in the paragraph bridging pages 1 and 2 of the first statement (Exhibit C), "Filterkuchenhöhe" (= filter cake height) in the section "Spezielle Anforderungen der Filtration" on page 2 of the first statement (Exhibit C), and "Filterkuchen" (= filter cake) in the section "Wirtschaftlichkeit" on page 2 of the first statement (Exhibit C) confirm this understanding. Further, a draft of the German patent application dated September 10, 1996 expressly mentions the prefloat filter

layers on page 7 in paragraph 6. See Exhibit H of Rettemaier Declaration; Exhibit H of Palgen Declaration. Accordingly, applicant submits that Tan et al. is not available as prior art against claims 36 and 37 of the present application.

In addition, applicant submits that claim 36, and its dependent claim 37, are patentable over Thompson for at least the same reason as claim 1.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is believed that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date: October 29, 2002

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